UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,488	09/19/2003	Aziz Hassan	BSN9	8014

7590 02/17/2006

Thomas L. Adams
120 Eagle Rock Avenue
P.O. Box 340
East Hanover, NJ 07936

EXAMINER	
NUTTER, NATHAN M	
ART UNIT	**PAPER NUMBER**
1711	

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/666,488	HASSAN ET AL.	
	Examiner	Art Unit	
	Nathan M. Nutter	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-16,18-27,31 and 32* is/are pending in the application.

4a) Of the above claim(s) *31 and 32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-16 and 18-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

In response to the amendment filed 7 December 2005, the following is placed in effect.

The rejection of claims 1, 16 and 25-28 under 35 U.S.C. 102(b) as being clearly anticipated by Tse et al, Dubois et al, or Baetzold et al is hereby expressly withdrawn.

Election/Restrictions

Newly submitted claims 31 and 32 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the invention of claims 31 and 32 is drawn to a method of making a polymer composition. Since the composition of the instant claims can be made by a materially different process, such as by a reactor blend, the claims are deemed to be properly restrictable.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31 and 32 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,552,110. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions are identical in scope and compositional limitations, possessing identical physical characteristics. The subsequent employment of the composition as a hot-melt adhesive and the production, thereof, by the simple mixing steps recited in instant claims would have been obvious steps within the skill of an artisan. A practitioner in the art would know to use the composition in hot-melt procedures.

Claims 1, 3-16 and 18-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,120,887. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions are identical in scope and compositional limitations, possessing identical physical characteristics. The subsequent production, thereof, by the simple mixing steps recited in instant claims would have been obvious steps within the skill of an artisan.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 3-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Yalvac et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 1, 3-16 and 18-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Werenicz et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Response to Arguments

Applicant's arguments filed 7 December 2005 have been fully considered but they are not persuasive.

With regard to the rejection of the claims1 and 3-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,552,110 to Yalvac et al, it is pointed out that the employment of the composition would, indeed, be known as useful to a skilled artisan as a hot melt adhesive on its own. However, the reference teaches this very concept at column 1 (lines 11-20). More specifically note column 3 (lines 52-58), "*(t)he adhesives of the invention,*" column 5 (lines 26-47), *"adhesive formulation,"* and especially at column 7 (lines 48-53), *"the hot melt adhesives."* It is not understood what more motivation a skilled artisan would need. Applicants respond to the double patenting rejection as though it were made in a scientific void, without having carefully and factually examining the reference to which the rejection is applied. Contrary to applicants' assertions, the suggestions and motivations are certainly provided by the teachings of the reference. Even if the composition was disclosed as only for use as a marking composition, as alleged by applicants, there would still be the need for the adhesive characteristics in order to be binding (or adhesive).

With regard to the rejection of claims 1, 3-16 and 18-27 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claims 1-25 of U.S. Patent No. 6,120,887, the reference is viewed as set out above. Applicants' response and characterization of the reference to Werenicz et al as "a fluid impermeable barrier layer," is greatly misleading and incorrect. Applicants' denial of the disclosure of the reference is not sufficient to overcome the rejections, as applied thereover. It is pointed out that a skilled artisan would know to employ the composition disclosed therein as an adhesive. The reference infers such at column 4 (lines 46 et seq.) as well as throughout the disclosure thereof. It is further pointed out that a reference is viewed for the entirety of its teachings.

As regards the rejection of claims 1 and 3-15 under 35 U.S.C. 102(e) as being anticipated by Yalvac et al, the reference clearly teaches and suggests the use of the composition as a hot melt adhesive. Applicants fail to point out how this is not so, especially since the patent teaches such. Again it is pointed out that a reference is viewed for its entirety, and not for isolated passages cited in an attempt to confer patentability on the claims. Applicants' assertions that the reference fails to teach the "other properties claimed" are not correct nor are they based on factual information. The reference teaches the use of "ultra low molecular weight ethylene alpha olefin copolymers at column 9 (lines 11-19). The reference then defines such at column 5 (lines 26-36) as having a number average molecular weight less than 11,000, which includes those recited and claimed herein. Since all compositional limitations, including the number average molecular weight, are taught, the compositions are essentially identical. These identical compositions would have identical inherent characteristics, which include the PAFT and SAFT values, as well as the Brookfield viscosity which

would be a function of the number average molecular weight. Since the values disclosed for number average molecular weight are shown by the reference, the other inherent characteristics recited would, likewise, be present. Patentees do not have to teach values for each and every inherent characteristic for that characteristic to be present. Applicants haven't shown on the record why these characteristics wouldn't be inherent. Contrary to applicants' assertions, the reference is deemed to show all elements of the claimed invention.

With regard to the rejection of claims 1, 3-16 and 18-27 under 35 U.S.C. 102(e) as being anticipated by Werenicz et al, applicants incorrectly contend that the reference fails to teach or disclose "the number average molecular weights (Mn) of the polymers used in the composition, the Brookfield viscosity of the polymers or of the hot melt adhesive composition." Applicants' attention is directed to the paragraph bridging column 5 to column 6, column 2 (lines 24-48) and column 4 (lines 46 et seq.) for the teachings of the hot melt adhesive. Applicants' attention is directed to column 12 (lines 33-37) for the number average molecular weights employed, including those recited and claimed herein, and to column 12 (lines 23-28) for the Brookfield viscosities, which clearly include those recited and claimed herein. As regards the inherent "adhesive properties such as PAFT or SAFT," the reference provides the identical composition with the identical number average molecular weight used in identical compositional limitations, and would inherently produce and possess these characteristics. Contrary to applicants' assertions, the reference is deemed to show all elements of the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

16 February 2006